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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,881	03/09/2004	Jesse D. Crum	WK/2004-08/US	2919

7590
WARD KRAFT, INC.
P.O. BOX 938
FORT SCOTT, KS 66701

06/13/2007

EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,881	Applicant(s) CRUM, JESSE D.	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-18, 23-25 in the reply filed on 14 November 2006 is acknowledged.
2. Claims 19-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 14 November 2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraft et al. (U.S. Patent 5,580,640).
5. Regarding claim 1, Kraft et al. discloses a communication substrate 20, comprising; a substrate 28 suitable for communicating a message to an intended recipient, said substrate having first 48 and second 50 faces, top 35 and bottom 26 edges and first 38 (left side in figure 1) and second 38 (right side in figure 1) sides; a coating 74 applied to at least a portion of said substrate 28 on at least one of said first

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and second faces, said coating having a starch component (see column 5, lines 3-7);
and a fracture area 40 created in said portion to provide at least one removable element 42.

6. Regarding claim 2, Kraft et al. discloses wherein said substrate is sized and configured to be handled by an imaging device (see column 5, lines 16-17).

7. Regarding claim 3, Kraft et al. discloses wherein said removable element 42 is selected from a group including cards, labels, tags, bands, placards, signs, tickets and combinations thereof.

8. Regarding claim 4, Kraft et al. discloses wherein said coating 74 creates a differential texture (includes large granular wheat starch).

9. Regarding claim 5, Kraft et al. discloses wherein said starch component is selected from a group including corn, potato, wheat, rice, tapioca, maize, sorghum, starch esters and starch flours and combinations thereof.

10. Regarding claim 6, Kraft et al. discloses wherein said coating 74 includes a second component selected from a group including varnishes, overcoatings, inks, adhesives, curable coatings and combinations thereof (coating 74 includes colorless dye, which may be considered an overcoating).

11. Regarding claim 9, Kraft et al. discloses wherein said fracture area 40 extends around a perimeter of said one removable element 42.

12. Regarding claim 10, Kraft et al. discloses wherein said coating 74 is applied in a pattern complimentary to said one removable element 42 (in the alternative embodiment

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as seen in figure 5, coating 74 is applied in a complimentary pattern surrounding removable element 42, see column 5, lines 7-11).

13. Claims 12-14, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraft et al. (U.S. Patent 5,580,640).

14. Regarding claim 12, Kraft et al. discloses a business form 20 having a removable card 42, comprising; a business form 28 having first 34 and second 44 areas, front 48 and back 50 faces, top 35 and bottom 26 edges and first 38 (left side in figure 1) and second 38 (right side in figure 1) sides; a fracturable coating 74 provided in a portion of one 44 of said first and second areas; and a crush pattern 40 applied to said portion to create at least one removable card 42 with said crush pattern provided around a perimeter of said at least one removable card.

15. Regarding claim 13, Kraft et al. discloses wherein said coating 74 includes a first starch component (includes large granular wheat starch) selected from a group including corn, potato, wheat, rice, tapioca, maize, sorghum, starch esters and starch flours and combinations thereof.

16. Regarding claim 14, Kraft et al. discloses wherein said coating includes a second component selected from a group including varnishes, overcoatings, inks, adhesives, curable coatings and combinations thereof (coating 74 includes colorless dye, which may be considered an overcoating).

17. Regarding claim 16, Kraft et al. discloses wherein said coating creates a differential tactile texture on said business form (includes large granular wheat starch).

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18. Regarding claim 18, Kraft et al. discloses wherein said at least one of said first and second areas are provided with printing (see column 3, line 65 to column 4, line 1).

19. Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kraft et al. (U.S. Patent 5,580,640).

20. Regarding claim 23, Kraft et al. discloses a business form 20 having at least one removable piece 42 provided integrally with the business form comprising; a substrate 28 capable of receiving printing or imaging (see column 5, lines 16-17), said substrate having front 48 and back 50 faces, top 35 and bottom 26 edges and first 38 (left side in figure 1) and second 38 (right side in figure 1) sides; a starch containing coating 74 provided on at least a portion of said substrate; a crush pattern 40 applied to said portion of said substrate to create a removable element 42 that is readily identifiable; and wherein said removable element with said coating is tactilely distinguishable from uncoated portions of said substrate (includes large granular wheat starch).

21. Regarding claim 24, Kraft et al. discloses wherein said coating 74 creates a discontinuous surface (the large granular wheat starch would inherently create a discontinuous surface).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al.

24. Regarding claim 7, Kraft et al. discloses the invention substantially as claimed, except Kraft et al. does not disclose wherein said starch component ranges from about 0.01% to about 99.9% by weight of said coating. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used whatever amount of starch was desired for the purpose of supplying the appropriate properties to the transfer medium, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

25. Regarding claim 11, Kraft et al. discloses the invention substantially as claimed, except Kraft et al. does not disclose wherein said removable element is removed from the fracture area by bending at least said portion of the substrate out of a horizontal plane. However, the Examiner takes Official Notice that it is well known in the art to remove a label by bending at least a portion of the substrate for the purpose of easily separating the label from the substrate.

26. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. in view of Jansen et al. (U.S. Patent 4,873,147).

27. Regarding claim 8, Kraft et al. discloses the invention substantially as claimed, except Kraft et al. does not disclose wherein said starch component is a starch ester

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having from 2 to 100 carbon atoms. Jansen et al. teaches a process in which a starch (including wheat starch, see column 2, lines 34-45) is esterized for the purpose of making a waterproof coating. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced the transfer medium coating 74 of Kraft et al. with the starch ester of Jansen et al. in order to have an alternative coating that does not allow the color developing material of layer 76 to transfer to the removable element 42.

28. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. in view of Weirather et al. (U.S. Patent Publication 2001/0007703 A1).

29. Regarding claim 15, Kraft et al. discloses the invention substantially as claimed, except Kraft et al. does not disclose wherein said at least one removable card is selected from a group including membership cards, business cards, identification cards, loyalty program cards, participation cards and combinations thereof. Weirather et al. teaches the use of a sheet construction 200 that includes a removable business card 700 for the purpose of allowing the full size sheet to be fed into a printer for supplying the desired information prior to removal of the card. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the detachable card of Kraft et al. with the business card of Weirather et al. in order to have a business form that provides a customer with a business card of the associated business.

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30. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al.

31. Regarding claim 17, Kraft et al. discloses the invention substantially as claimed, except Kraft et al. does not disclose wherein said starch component ranges from about 0.01% to about 99.9% by weight of said coating. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used whatever amount of starch was desired for the purpose of supplying the appropriate properties to the transfer medium, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

32. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al.

33. Regarding claim 25, Kraft et al. discloses a business form 20 containing a fracturable coating 74, comprising; a substrate 28 having a front face 48 and a back face 50, a coating 74 applied to at least a portion of one of said front and back faces; a crush pattern 40 applied to said portion to create a removable element 42. Kraft et al. does not disclose wherein said coating with said crush pattern enable said removable element to be released from said portion by bending or flexing said substrate. However, the Examiner takes Official Notice that it is well known in the art to remove a label by bending at least a portion of the substrate for the purpose of easily separating the label from the substrate.

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Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
8 June 2007



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SUPERVISORY PATENT EXAMINER